

REMARKS

Claims 1-20 are pending in the application.

Claims 1-17, 19 and 20 have been rejected.

Claim 18 has been objected to.

Claims 1 and 11 have been amended to correct minor informalities.

No new matter has been added.

Reconsideration of the Claims is respectfully requested.

1. Rejection under 35 U.S.C. § 102(a)

Applicant notes with appreciation the Examiner's consideration of the Applicant's response filed December 9, 2004.

Claims 1 and 3-16 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,852,775 (hereinafter "Hidary").

Hidary is directed to, in view of the expense that has existed with advertisement services to subscribers, "integrating the advertisement material with normal telephone communications thereby reducing the cost of normal services to subscribers." (Hidary Col. 1:15-18, 1:25-28). The Mobile Telephone Switching Office (MTSO) 12 of Hidary "takes the necessary steps to establish a standard telephone connection 30 to the nonsubscriber 28. In step 116 after the commercial message to subscriber 16 is completed, the connection 30 is completed and the subscriber 16 either hears a standard ring for nonsubscriber 28 or hears a busy signal, dependent on the state of the non-subscriber's equipment. The remainder of the operation of the system is the same as with any other standard cellular telephone system." (Hidary Col. 3:30-37; *see also* Col. 2:50-57 ("In step 100 [MTSO] receives a request for an open channel") (emphasis added)). That is, the implicit time-dependence of the term "standard" relates to insertion of a single message during establishment of a standard connection with a subscriber. (*see also* Hidary Claim 1 ("said central station [(MTSO)] includes: first connectors for exchanging information with said telephones through said cell transceivers; (b) second connectors for connecting said central station to a standard hardwired telephone system; (c) a commercial message center")).

In contrast, Applicant's claimed invention of Claim 1 recites, *inter alia*, an "information server, comprising: . . . a memory including computer instructions that define logic to prompt the

information server . . . to be transmitted to the mobile terminal through a wireless data packet network” (See also Figure 1; p. 14:1-12 (“a functional block diagram of a network for delivering information to a wireless terminal”))

Also, the elements of dependent claims 8 and 10 are not found in Hidary. Claim 8 recites that “the computer instructions define logic to transmit the customer profile information to a vendor server that is proximate to the cell within which the mobile terminal is registered.” Claim 10 recites that “the customer profile information is transmitted to the vendor server to prompt it to generate an advertisement to the mobile terminal.”

Further, Hidary does not anticipate the method Applicant’s claimed invention of Claim 11, which recites, *inter alia*, a “method for delivering an advertisement to a mobile terminal comprising: . . . determining, based upon the mobile terminal location, whether a vendor should be sent customer profile information to a vendor server for it to determine whether a push data message should be sent to the mobile terminal”

The Office Action states that “Hidary discloses that customer profile data . . . are transmitted ‘to ad server 24 in order to receive the push ads (if appropriate)’” But Hidary recites “the message is sent by ad server 24 to [MTSO] 12 which in response sends it onto the subscriber.” (Hidary Col. 3:24-28). Hidary “takes the necessary steps to establish a standard telephone connection 30 to the nonsubscriber 28. In step 116 after the commercial message to subscriber 16 is completed, the connection 30 is completed and the subscriber 16 either hears a standard ring for nonsubscriber 28 or hears a busy signal, dependent on the state of the non-subscriber’s equipment. The remainder of the operation of the system is the same as with any other standard cellular telephone system.” (Hidary Col. 3:30-37; *see also* Col. 2:50-57. That is, as part of the MTSO operation (*see* Hidary Claim 1), the commercial message is provided in the standard telephone call connection to the subscriber.

Accordingly, Applicant respectfully submits that each and every element as set forth in Applicant’s Claim 1 and Claims 3 through 10 that depend directly or indirectly therefrom, and in Applicant’s Claim 11 and Claims 12 through 16 that depend directly or indirectly therefrom, is not found, either expressly or inherently described, in Hidary. Applicant respectfully requests that the rejection to these claims be withdrawn.

2. Rejection under 35 U.S.C. § 103(a)

Claims 19 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary and further in view of U.S. Patent No. 5,950,125 (hereinafter "Buhrmann"). Claims 2 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary.

Claims 19 and 20 depend from Claim 11. In this regard, because Hidary does not anticipating Applicant's claimed invention of Claim 11, Applicant submits that there is no suggestion or motivation to combine Hidary with Buhrmann as set out in the Office Action.

The location-dependent cellular service profile of Buhrmann was cited for use of picocells (*see* Office Action at p. 6). It appears, however, that Applicant's disclosure was used to piece together Buhrmann with Hidary. Accordingly, Applicant respectfully submits that a *prima facie* case of obviousness has not been established with respect to Claim 19. As discussed below, it is respectfully submitted that the cited references do not provide a suggestion or motivation to modify them to achieve the invention recited in Applicant's dependent Claims 2-9.

With respect to the rejection of Claim 20, the Office Action sets out that Official Notice in the Office Action mailed September 9, 2004, that "both the concept and advantages of cell phone networks using GPRS or UMTS and detected events including travel conditions based on user location would have been well known and expected in the art of cell networks," and that without traversal, such statements are taken as admitted fact. Applicant is not familiar with the notion that Official Notice without traversal constitutes an admitted fact. Notably, Official Notice is for use in limited circumstances. MPEP 2144.03. In context, Official Notice is for facts asserted to be well-known, or to be common knowledge in the art that are capable of instant and unquestionable demonstration as being well-known. The quoted statement, however, appears to recite opinion, not a fact that is well-known or to be common knowledge in the art. Generally, the statement appears to be based upon the teachings of Applicant's specification. (*See, e.g.,* Applicant's Claim 17 "wherein the event is that a specified travel condition has occurred.").

Accordingly, Applicant respectfully submits that there is no suggestion or motivation leading one of ordinary skill in the art to combine the references as set out, or that a *prima facie* showing under Hidary has not been established. It is respectfully submitted that dependent claim 2, and dependent claims 17, 19, and 20 are allowable, and requests that the rejections be withdrawn.

3. Allowable Subject Matter

Claim 18 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Applicant greatly appreciates the indication of allowability.

4. Conclusion

As a result of the foregoing, the Applicant respectfully requests an early allowance of the pending claims 1-20.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *ksmith@texaspatents.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Garlick Harrison & Markison Deposit Account No. 50-2126.

Respectfully submitted,

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